

REMARKS

The examiner rejects claims 1, 2, 4, 5, 7-13, and 19 under 35 U.S.C. 103(a) as being obvious over the patent to Janky in view of the patent to Bi. Taking claim 1 of the instant application as an example, Applicant claims a mobile device that includes a positioner to determine geographic position information for the mobile device, and a transceiver that transmits the position information if the positioner can determine such information, and transmits a continuous tone if the positioner cannot determine position information. Transmission of the continuous tone enables the supporting wireless communication network to locate the mobile device, based on triangulating the continuously transmitted tone.

The examiner states that Janky teaches a location determining unit that transmits position information through a cellular phone. However, the examiner acknowledges that Janky does not teach or suggest a mobile device that transmits position information when that information is available, and transmits a continuous tone when the information is not available. The examiner states that Bi provides such teachings, and that such teachings are combinable with Janky, thereby making the present invention obvious.

Simply put, Bi provides no teachings relevant to the claimed invention. Bi teaches a conventional mobile-telephone operating in a network that has "location terminals" distributed in the network's cells. These location terminals receive information identifying the traffic channel assignments and synchronization timing for specific mobile-telephones, and then use that information to determine mobile-telephone positions based on monitoring traffic channel transmissions from the mobile-telephones. The mobile-telephones of Bi do not send any positioning information, nor do they transmit continuous tones to facilitate network-based position determination. Bi's invention resides within the network itself, and Bi thus offers no teachings relevant to the claimed invention.

In short, the examiner's Office Action explicitly acknowledges that Janky fails to teach the claimed invention, and his reliance on a flawed understanding of Bi leaves the obviousness

rejections unsupportable as a matter of law. As an example of the examiner's erroneous characterization of Bi, Applicant notes that the examiner's rejection arguments state that col. 7, lines 19-37 of Bi teach a mobile-telephone that transmits position information if it is able to do so, and otherwise transmits a continuous tone. The cited section of Bi describes only the conventional transmission of traffic channel signals from mobile-telephones responsive to base station signaling, and the corresponding use of such traffic channel signals for position determination by the location terminals of Bi.

Put plainly, Bi does not teach (or even vaguely suggest) what the examiner asserts it does, and the examiner's combination of Bi with Janky does not produce the claimed invention; therefore the examiner's obviousness rejections fail as a matter of law and must be withdrawn. Additionally, the obviousness rejections fail as a matter of law because the examiner has failed to show any motivation to combine Bi with Janky.

Indeed, the examiner's proffered motivation to combine Bi with Janky fails even a cursory analysis. Specifically, the examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Bi to said device of Janky in order to more accurately determine the location of a mobile device without increasing interference for other mobile telephones in the same area." That assertion by the examiner is curious because Bi teaches the use of specialized location receivers within the network to process conventional traffic channel signals from conventional mobile-telephones, and it is wholly unclear whether there would be any motivation to combine Bi with Janky.

Indeed, Janky takes it as a given that some type of location determination can be performed by or for the cellular phones that are used in Janky for clandestinely locating stolen cars. It is illogical to argue that one would be motivated to add the expense and complexity of Bi's location terminals--which are added to Bi's wireless network--to the network of Janky, when Janky discloses any number of apparently satisfactory methods of locating cellular phones. There is not even any basis for the examiner to conclude that Bi's location terminals offer more

accurate position determination that the methods disclosed by Janky. The examiner's failure to articulate any meaningful basis for motivating one skilled in the art to combine Bi with Janky underscores the inapplicability of Bi to Janky.

Finally, the Examiner asserts that the claims lack sufficient detail to state that the mobile device must strictly initiate one action or another (i.e., transmitting its geographical position or the tone). *Office Action*, pg. 8, ll. 7-11. Applicant disagrees. Claim 1 explicitly recites that the mobile device transmits its geographical position information, **"if the positioner is able to determine the geographic position information,"** and continuously transmits a tone, **"if the positioner is not able to determine the geographic position information."** This language is unambiguous, and plainly recites what the mobile device transmits and under what circumstances. Neither Janky nor Bi, alone or in combination, teaches or suggests a mobile device that transmits its geographic position information or a tone depending upon whether the mobile device can or cannot determine its own geographic position.

The Examiner also rejected claims 11 and 19 under 35 U.S.C. §103(a) as being unpatentable over the patent to Janky in view of the patent to Bi for reasons similar to those cited for claim 1. However, both claims 11 and 19 include language similar to that of claim 1. Therefore, for the reasons stated above, neither Janky nor Bi, alone or in combination, teach or suggest claims 11 and 19.

Accordingly, Applicant respectfully requests the allowance of all pending claims.

Respectfully submitted,

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